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UNITED STATES PATENT AND
TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY R. EDDY

Appeal 2008-1504
Application 10/033,580
Technology Center 3600

Decided: September 9, 2008

Before HUBERT C. LORIN, MURRIEL E. CRAWFORD, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-16, and 18-22. Claims 2 and 17 have been

cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We
AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to a support bracket with a main beam, a connection element, a hook, and first and second legs. (Specification, 2:13-25). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. An eaves trough support bracket, comprising:
 - (a) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces;
 - (b) a connection element extending in a first transverse direction from the distal end of the main beam and having a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam;
 - (c) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction;
 - (d) a first leg extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam; and
 - (e) a second leg extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam,
 - (f) wherein the main beam, first leg and second leg define a concavity accessible from the first transverse direction whereby the support bracket is transversely nestable.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Odekirk	US 4,294,422	Oct. 13, 1981
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The following rejections are before us for review:

1. Claims 1, 3-16, and 18-20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to provide support for the claimed limitation “transversely nestable”.
2. Claim 22 is rejected under 35 U.S.C. § 112, second paragraph as failing to show overlapping of the primary rib and the leg.
3. Claims 1, 3-16, and 18-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Odekirk.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence¹:

FF1. In the Specification, Figure 1-4 show the legs 110 and 120 extending straight down which would preclude transverse nestability for the bracket. The Specification fails to provide any specific teaching that the bracket is transversly nestable.

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. In the Specification, Figure 2 shows the rib 131 spaced longitudinally from the legs 110 and 120. As the rib 131 and the legs 110 and 120 are spaced apart, the rib cannot longitudinally overlap the legs.

FF3. Odekirk does not disclose a bracket with legs which are transversely nestable (Figures 1-3).

FF4. Odekirk does not disclose a bracket with legs which have a transverse height that tapers (Figures 1-3). Odekirk's leg 22 has seven individual sections which span its length.

FF5. Odekirk does not disclose a bracket with a primary rib which longitudinally overlaps the legs (Figures 1-3).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

Claims 1, 3-16, and 18-20 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to provide support for the claimed limitation “transversely nestable” (Ans. 3-4). The Appellant argues that “[w]hile the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration, Figures 1-4 clearly illustrate a bracket with the inherent function of nestability” (Br. 6). The Appellant argues that support for the invention being “transversely nestable” is found in Figures 1-4 (Br. 6).

In contrast, the Examiner has determined that the Figures do not disclose that the legs are nestable since the legs 110 and 120 extend straight down as shown in Fig. 4 (Ans. 8-9).

We disagree with the Appellant. The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The possession test alone, however, is not always sufficient to meet the written description requirement. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). Rather, “the written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Id.* (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). Here, the Appellant has acknowledged that “the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration” (Br. 6). Figures 1-4 which are relied upon by the Appellant for inherently

showing transverse nestability of the bracket do not inherently disclose such a feature either. In Figures 1-4 the legs 110 and 120 extend straight down (see Fig. 4). Since the legs 110 and 120 extend straight down and are not flared outwardly the bracket cannot be transversely nestable (FF 1). The Appellant's Specification and Figures do not fully set forth or provide any support inherently for the claimed transverse nestability of the bracket. For the above reasons, the rejection of claims 1, 3-16, and 18-20 under 35 U.S.C. § 112, first paragraph is sustained.

Claim 22 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Appellant argues that the rejection of claim 22 under 35 U.S.C. § 112, second paragraph is improper because Figures 1-5 provide support for the primary rib to longitudinally overlap the first and second leg (Br. 6). The Appellant argues that the primary rib 131 runs in longitudinal direction x^2 (Fig. 2) and therefore overlaps the first leg 110 (Br. 6).

In contrast the Examiner argues that rib 131 fails to contact or cover the legs 110 and asserts that the rejection under 35 U.S.C. § 112, second paragraph is proper (Ans. 8-9).

We disagree with the Appellant. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). Here it is unclear how the rib 131 can overlap or cover even a part of the legs 110 and 120 if it is laterally spaced from the legs and therefore prevented from spanning the same longitudinal direction (FF2). As it is unclear how the rib could

overlap the legs, those skilled in the art would not understand what is claimed in claim 22 when read in light of the Specification. For these reasons, the rejection of claim 22 under 35 U.S.C. § 112, second paragraph is sustained.

Claims 1, 3-16, and 18-22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Odekirk.

The Appellant argues that the rejection of claim 1, 3-16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is improper because that bracket is not nestable (Br. 8). The Examiner argues only that if the Appellant's bracket is nestable, then Odekirk's would be nestable as well (Ans. 9).

We agree with the Appellant. Odekirk does not disclose a bracket with legs which are transversely nestable (FF3). For this reason, the rejection of claims 1, 3-16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is not sustained.

The Appellant argues that the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is improper because it fails to disclose legs with a transverse height that tapers. The Appellant argues that Odekirk's legs have a uniform transverse height along the entire length of the main beam (Br. 8). The Examiner states that the use of transverse heights for the legs is a matter of design preference (Ans. 7).

We agree with the Appellant. Odekirk does not disclose a bracket with legs which have a transversely height that tapers (FF4). The Examiner argues that use of a transverse heights in the legs is a matter of design

preference. The leg 22 in Odekirk's device is very thin and contains seven individual sections which make up its length (FF 4). Modifying the leg of Odekirk to have a transverse height that tapered would require a more complicated manufacturing process made difficult by the thin leg and six bends in leg. There is not a well articulated reasoning with sufficient rational underpinning to support a legal conclusion of obviousness for modifying the leg of Odekirk to have a transverse height that tapered. For this reason, the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is not sustained.

The Appellant argues that the rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is improper because it fails to show a primary rib which longitudinally overlaps the legs (Br. 9). The Examiner agrees and only states that if the Applicant's bracket is has a rib that longitudinally overlaps the legs, then Odekirk's would do so as well (Ans. 10).

We agree with the Appellant. Odekirk does not disclose a bracket with a primary rib which longitudinally overlaps the legs (FF5). For this reason, the rejection of claims 22 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1, 3-16, and 18-20 under 35 U.S.C. § 112, first paragraph.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 22 under 35 U.S.C. § 112, second paragraph.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1, 3-16, and 18-21 under 35 U.S.C. § 103(a) as being unpatentable over Odekirk.

DECISION

The Examiner's rejection of claims 1, 3-16, 18-20, and 22 is sustained. The Examiner's rejection of claim 21 is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2008-1504
Application 10/033,580

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